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IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DEBASISH BANERJEE and KENTAROH NOJI

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Appeal 2007-0914  
Application 09/904,734  
Technology Center 2100

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Decided: March 31, 2008

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Before JAMES D. THOMAS, JOHN C. MARTIN,  
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In a paper filed November 5, 2007, Appellants request that we rehear our decision dated September 5, 2007, wherein we affirmed the Examiner's rejections of all claims on appeal under 35 U.S.C. § 103. The above-noted panel only recently received this request for rehearing.

First, as indicated collectively from our discussions at pages 4-5, page 6, and pages 7-8 of our prior Decision, we sustained each of the Examiner's separately stated rejections of claims 1 through 27 under 35 U.S.C. § 103. We set forth our responses to Appellants' arguments that were either not addressed by the Examiner or we embellished upon the Examiner's views.

Second, because Appellants' reference to the paragraph bridging pages 5 and 6 of our original opinion incompletely quotes the entire paragraph at page 2 of the Request, we reproduce it here:

We direct attention to Appellants' Specification, which appears to admit that all features of claim 12 were known in the art at the time the invention was made. Appellants admit that the HTTP specification contains an optional header that may contain character set information (Specification, ¶8). While the use of this header by a client is optional, a fully compliant HTTP server receiving an HTTP request must still determine if a request header (the Content-Type header) composed according to a network communications protocol (HTTP) received with a client request from the at least one client computer designates a character set. Appellants further admit that it is known to select a character set when the Content-Type header fails to specify a character set (Specification, ¶9). Appellants also admit that, upon determining that the client request does not designate a character set, a well known API, developed by Sun Microsystems, may be invoked to retrieve locale information from the client request in order to determine an associated character set (Specification, ¶35). In the context of these admissions, it is implicit to translate server locales to a character set, particularly in view of the recognition in paragraph 9 of the Specification that it is known to select a character set when the Content-Type header fails to specify a character set. Therefore, we find the weight of the evidence shows that the subject matter of claim 12 was within the admitted prior art.

The last sentence of this paragraph indicated that we also found from the weight of the evidence that the subject matter of representative independent claim 12 was within the admitted prior art. This paragraph discussed in detail our understanding of Appellants' admissions with respect to the revelations of the prior art provided by paragraphs 8, 9, and 35 in the Specification as filed. The bulk of the Appellants' views from pages 2 through 4 of the Request discuss only the subject matter of paragraph 35, whereas the reader would clearly conclude that our reasoning included as well the subject matter discussed in paragraphs 8 and 9. Thus, Appellants' reasoning in the request is silent as to any of their views about what we said the admissions of the prior art were as contained in paragraphs 8 and 9.

We clarify now that paragraph 35 constitutes an admission only to the extent it states that the prior art included a "ServletRequest.getLocale0" Application Programming Interface (API) developed by Sun Microsystems for extracting the locale from an HTTP request. The Specification does not admit that it was known to derive the user's preferred character set from the user's extracted locale.

Nevertheless, in light of the foregoing admitted subject matter it would have been obvious, in the case where a request does not include a header identifying the user's preferred character set, to select the user's preferred character set based on the user's locale, by (1) using the known ServletRequest.getLocale0 API to identify the requester's locale and (2) using the requester's locale to make an educated guess at the user's preferred character set. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("The second error of the Court of Appeals lay in its assumption

that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem. . . . Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). The teachings of the admitted prior art thus combined satisfy claim 12 and alternative (a) in each of independent claims 1 and 16.

In other words, we concluded at the end of the above-noted paragraph that it was implicit to translate server locales to a character set, particularly in view of the recognition in paragraph 9 of the Specification teaching the prior art that it was known to select a character set when the Content-Type header failed to specify a character set.

The Supreme Court has found that “[i]n making the determination of ‘obviousness,’ it is important to remember that the criterion is measured not in terms of what would be obvious to a layman, but rather what would be obvious to one ‘reasonably skilled in (the applicable) art.’” *Dann v. Johnston*, 425 U.S. 219, 229 (1976) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 37 (1966)). In *Dann*, the Supreme Court reached a finding of obviousness by concluding that “[a]ssuming such an awareness, respondent’s system would . . . have been obvious to one ‘reasonably skilled in (the applicable) art’” even though, as the court explicitly noted, “[t]here may be differences between respondent’s invention and the state of the prior art.” *Dann*, 425 U.S. at 229 (quoting *Graham*, 383 U.S. at 37). In particular, we note that the Supreme Court held in *Dann* that “the mere

existence of differences between the prior art and an invention does not establish the invention's nonobviousness . . . [where] [t]he gap between the prior art and respondent's system is simply not so great as to render the system nonobvious to one reasonably skilled in the art." *Dann*, 425 U.S. at 230 (holding that claims directed to a machine system for automatic record keeping of bank checks and deposits were obvious in view of the use of data processing equipment and computer programs in the banking industry at the time of the invention in combination with a prior art automatic data processing system using a programmed digital computer for use in a large business organization).

We note that our reviewing court has determined that the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir 2006) (*citing In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)). Moreover, the Supreme Court has stated that the analysis under § 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741.

We note our reviewing court has also recently more comprehensively reaffirmed that:

an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for

example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient . . . . In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

*DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) (emphasis in original). *See also KSR*, 127 S. Ct. at 1738 (citing with approval *DyStar*, 464 F.3d at 1367).

Very similar to the concept of common sense, *KSR* also emphasizes the creativity of a person having ordinary skill in the art and its role in determining nonobviousness. The reason to combine the prior art can be found in the scope of normal creativity. Courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S. Ct. at 1741. A certain level of creativity is a part of the knowledge base of the prior art. “A person of ordinary skill is . . . a person of ordinary creativity, not an automaton. *Id.* at 1742. Thus, if an invention falls within the scope of creativity of the person having ordinary skill in the art, it is not an innovation that should be protected.

Our prior decision did not indicate that there was an express teaching or suggestion among the prior art discussions in paragraphs 8, 9, and 35 as reflected again in the above-quoted paragraph. On the other hand, we did state that we regarded the subject matter of representative claim 12 as implicitly obvious to the artisan from the discussion of the prior art at Specification paragraphs 8, 9, and 35.

Claims presented for examination must read over the prior art, admitted or not, within 35 U.S.C. § 103 as the case law of our prior decision at pages 6 and 7 compellingly indicates.

Lastly, at page 4 of the request Appellants essentially request that we remand this application to the Examiner to reopen prosecution to enter a rejection based upon our analysis, giving Appellants a fair and reasonable chance to respond.

Our prior decision did not designate our position as a new ground of rejection. But to the extent any reader may consider it as such, Appellants had a fair and reasonable opportunity to respond to it by filing the Request for Rehearing in a timely manner, which they did, and this decision constitutes our decision with respect to the Request for Rehearing. Thus, by filing the Request for Rehearing, Appellants had a fair and reasonable opportunity to respond to any issues raised in our prior decision. As indicated earlier in this opinion, Appellants have chosen to incompletely respond to our actual reasoning set forth in the paragraph bridging pages 5 and 6 of our prior decision that we reproduced earlier in this opinion. Since Appellants sought rehearing of a prior decision, and since we have herein rendered a decision on Appellants' Request for Rehearing, Appellants' administrative due process interests have been preserved. Paraphrasing the case law from our reviewing court at pages 6-7 of our prior decision, admissions are binding on Appellants for purposes of a later inquiry into obviousness and there is no inherent unfairness or unreasonableness in holding Appellants to the consequences of their admissions.



In other words, what process within the PTO is due Appellants when Appellants have full awareness and actual notice of their own Specification as filed? Appellants have had a full opportunity to carefully consider the consequences of their own admissions as made in the Specification, and also any additional admissions made during the prosecution history. Therefore, any reliance upon Appellants admissions by the PTO cannot be considered a surprise to them. Appellants have had a fair opportunity to react to the thrust of their own admissions as relied upon by us in our prior Decision, the filing of their Request for Rehearing, and this Decision on the rehearing.

The dependent claims are not separately argued and accordingly fall with the independent claims.

In view of the foregoing, we have considered in detail Appellants' Request for Rehearing of our prior decision, but are not persuaded by the request to make any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

MARTIN, *Administrative Patent Judge*, concurring.

I concur in my colleagues' conclusion that the claimed subject matter would have been obvious over the admitted prior art discussed in paragraphs 8, 9, and 35 of Appellants' Specification.

Unlike my colleagues, however, I agree with Appellants that the holding of obviousness based on the admitted prior art should have been and should be designated as a new ground of rejection under 37 C.F.R. § 41.50(b), thereby giving Appellant an opportunity to respond to that obviousness rationale with an amendment and/or new evidence to be considered by the Examiner during reopened prosecution. Designation as a new ground is necessary because Appellants have not had a fair opportunity to react to the thrust of the "affirmance" of the rejection, which is based on admitted prior art that was not relied on by the Examiner. *See In re Kumar*, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection") (quoting *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976)). This principle should apply even where, as here, the rationale used to "affirm" the rejection is based on admissions in Appellants' own Specification, because this new rationale, at least insofar as claim 12 is concerned, has nothing whatsoever in common with the Examiner's rationale, which was based only on the cited U.S. patent references.

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